



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,407	05/25/2000	David L. Bates	TMC-101US	7415

23598 7590 11/10/2003

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.
250 E. WISCONSIN AVENUE
SUITE 1030
MILWAUKEE, WI 53202

EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,407

Applicant(s)

BATES ET AL.

Examiner

Luke Gilligan

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. In the amendment filed 8/14/03 in paper number 5, the following has occurred: claims 1, 11, and 20 have been amended. Now, claims 1-24 are presented for examination.
2. The rejections under 35 U.S.C. 101 are withdrawn by the Examiner based on changes made by Applicants to the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 11-18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Danilunas et al., U.S. Patent no. 6,263,320.
5. As per claim 1, Mitcham teaches a method of generating an insurance quote for an individual, comprising the steps of: obtaining data from an applicant for insurance (see column 5, lines 12-28); automatically underwriting an insurance risk for an item using the data obtained from the applicant (see column 6, lines 4-10); and providing an insurance quote to the applicant in response to the step of underwriting the insurance risk, wherein the insurance quote is for the provision of insurance to cover the item (see column 6, lines 10-25).
6. Mitcham does not explicitly teach obtaining data from a lender's database and using the data to underwrite a corresponding insurance risk. Danilunas teaches a method for utilizing a financial product for the financing of an automobile purchase and storing related information in a database (see column 2, lines 8-18 and column 4, lines 2-8); and further utilizing the method to provide automobile insurance to the potential purchaser of the automobile (see column 5, lines

Art Unit: 3626

5-24). It would have been obvious to one of ordinary skill in the art of automobile financial services to incorporate this feature of connecting insurance providers and lenders for the purpose of enabling the selling of such financial services at a discounted rate (see column 5, lines 5-7 of Danilunas).

7. As per claim 2, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham does not explicitly teach providing the insurance quote by the lender.

Danilunas teaches a method for utilizing a financial product for the financing of an automobile purchase and further providing automobile insurance to the potential purchaser of the automobile (see column 5, lines 5-24). It would have been obvious to one of ordinary skill in the art of automobile financial services to incorporate this feature of connecting insurance providers and lenders for the purpose of enabling the selling of such insurance services at a discounted rate (see column 5, lines 5-7 of Danilunas).

8. As per claim 3, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham further teaches the insurance quote is provided by an insurance provider (see column 6, lines 1-4).

9. As per claim 4, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham further teaches the step of underwriting the insurance risk includes the additional steps of: providing a plurality of insurance companies for underwriting the insurance risk (see column 5, lines 58-65); and determining a set of terms for each of the plurality of insurance companies for which each of the plurality of insurance companies will accept the insurance risk (see column 5, line 66 – column 6, line 4).

10. As per claim 5, Mitcham in view of Danilunas teach the method of claim 4 as described above, comprising the additional step of selecting one of the sets of terms and providing the insurance quote in response thereto (see column 6, lines 15-19).

Art Unit: 3626

11. As per claim 6, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham further teaches the additional step of determining if additional data is needed prior to underwriting the insurance risk and if the additional data is needed, conducting the step of obtaining the additional data from the applicant (see column 6, lines 39-45).

12. As per claim 7, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham further teaches the additional steps: storing the data after providing the insurance quote (see column 8, lines 38-41); and providing an additional insurance quote in response to a request by the applicant (see column 8, lines 55-59).

13. As per claim 8, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham further teaches the step of requesting permission from the applicant prior to obtaining data from additional sources (see column 43-58).

14. As per claim 9, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham further teaches a second portion of the data is obtained from a third party (see column 7, lines 55-61).

15. Claims 11-18 and 20-23 contain substantially similar limitations to claims 1-9 and, as such, are rejected for similar reasons as given above.

16. Claims 10, 19, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Danilunas et al., U.S. Patent no. 6,263,320 and further in view of Dugas, **Not the total solution Bankruptcy stays on credit reports.**

17. As per claim 10, Mitcham in view of Danilunas teach the method of claim 1 as described above. Mitcham does not explicitly teach that the third party is a credit bureau. Dugas discloses third party reporting of information for an application for insurance (see paragraph 7). It would have been obvious to one of ordinary skill in the art of insurance processing at the time

Art Unit: 3626

of the invention to include the step of obtaining data in the system of Mitcham from a third party as disclosed by Dugas. One of ordinary skill in the art would have been motivated to perform such a step for the purpose of determining applicant's who pose a bad credit risk (see paragraph 8 of Dugas).

18. Claims 19 and 24 contain substantially similar additional limitations to claim 10 and, as such, are rejected for similar reasons as given above.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Joao teaches a system and method for providing lease insurance.
- Hielscher discloses banks sharing information from car loan applicants with insurance providers for the purpose of providing insurance to the potential buyer.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3626

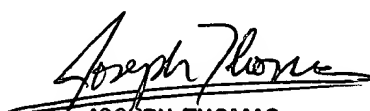
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


CLG
11/3/03


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600